UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,647	08/14/2001	Hiroko Sugimoto	NAK1-BP74	9533

21611 7590 10/07/2004

SNELL & WILMER LLP
1920 MAIN STREET
SUITE 1200
IRVINE, CA 92614-7230

EXAMINER	
SHELEHEDA, JAMES R	
ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/929,647	SUGIMOTO ET AL.	
	Examiner	Art Unit	
	James Sheleheda	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7-14,17 and 19-21* is/are pending in the application.

4a) Of the above claim(s) *20 and 21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-14,17 and 19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 20 and 21 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: They belong to a previously restricted group IV.

Since applicant elected group III in Paper No. 5, claims 20 and 21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. This application contains claim 20 and 21 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7, 8, 17 and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Grossman et al. (Grossman) (5,907,321) (previously presented).

As to claim 7, Grossman discloses a content reproduction apparatus (Fig. 3, subscriber unit, 24a; column 5, lines 65-67 and column 6, lines 1-7), comprising:

content storing means (RAM, 44) for storing commercial content (column 6, lines 33-38 and column 3, lines 31-45);

receiving means (tuner, 72) for receiving broadcast programs (column 6, lines 19-25 and lines 52-54);

first reproducing means for reproducing the received broadcast programs on a monitor (Fig. 3; modulator, 78 to TV, 30; column 6, lines 2-4);

registered instruction storing means (ROM, 40) for storing one or more specified user instructions (column 4, lines 55-58 and column 6, lines 11-18);

instruction receiving means (remote control receiver, 48) for receiving user instructions (column 6, lines 11-15);

instruction judging means (microprocessor, 60) for judging whether the received user instruction corresponds to any of the stored user instructions (wherein the microprocessor determines whether a received command is a channel change command; column 4, lines 55-58 and column 6, lines 11-18);

control means (microprocessor, 60 executing the display method; column 6, lines 8-11) for controlling a reproduction period of the stored commercial content (time period in which the commercial can be displayed; column 5, lines 6-20) in accordance with a type of the received user instructions (in accordance with received channel change commands; column 5, lines 11-20); and

second reproducing means for reproducing the stored commercial content on the monitor (column 6, line 67 and column 7, lines 1-8) under the reproduction period control of the control means (column 5, lines 6-20 and column 6, lines 8-11) when the received user instruction is judged to one of the stored user instructions (column 6, line 67 and column 7, lines 1-8).

As to claim 8, Grossman discloses the second reproducing means including display-mode controlling means (graphics generator, 68) for controlling a reproduction display-mode of the commercial content (column 7, lines 29-42) in accordance with the type of the user instruction (wherein the content is displayed upon receipt of the channel change command; column 7, lines 13-18) judged to correspond to one of the stored user instructions (wherein the microprocessor determines whether a received command is a channel change command; column 4, lines 55-58 and column 6, lines 11-18).

As to claim 17, Grossman discloses a reproduction method for a content reproduction apparatus (Fig. 3, subscriber unit, 24a; column 5, lines 65-67 and column 6, lines 1-7) having both content storing means (RAM, 44) for storing commercial content (column 6, lines 33-38 and column 3, lines 31-45) and registered instruction storing means (ROM, 40) for storing one or more specified user instructions (column 4, lines 55-58 and column 6, lines 11-18), comprising:

a receiving step (using tuner, 72) for receiving broadcast programs (column 6, lines 19-25 and lines 52-54);

a first reproducing step for reproducing the received broadcast programs on a monitor (Fig. 3; modulator, 78 to TV, 30; column 6, lines 2-4);

an instruction receiving step (using remote control receiver, 48) for receiving user instructions (column 6, lines 11-15);

an instruction judging step (using microprocessor, 60) for judging whether the received user instruction corresponds to any of the stored user instructions (wherein the microprocessor determines whether a received command is a channel change command; column 4, lines 55-58 and column 6, lines 11-18);

a control step (through microprocessor, 60 executing the display method; column 6, lines 8-11) of controlling a reproduction period of the stored commercial content (time period in which the commercial can be displayed; column 5, lines 6-20) in accordance with a type of the received user instructions (in accordance with received channel change commands; column 5, lines 11-20); and

a second reproducing step for reproducing the stored commercial content on the monitor (column 6, line 67 and column 7, lines 1-8) under the reproduction period control of the control step (column 5, lines 6-20 and column 6, lines 8-11) when the received user instruction is judged to one of the stored user instructions (column 6, line 67 and column 7, lines 1-8).

As to claim 19, Grossman discloses a recording apparatus (Fig. 3; ROM, 40) for recording a computer program (column 6, lines 15-18 and lines 33-38) which is used by a content reproduction apparatus (Fig. 3, subscriber unit, 24a; column 5, lines 65-67

and column 6, lines 1-7) having both content storing means (RAM, 44) for storing commercial content (column 6, lines 33-38 and column 3, lines 31-45) and registered instruction storing means (ROM, 40) for storing one or more specified user instructions (column 4, lines 55-58 and column 6, lines 11-18), comprising:

a receiving step (using tuner, 72) for receiving broadcast programs (column 6, lines 19-25 and lines 52-54);

a first reproducing step for reproducing the received broadcast programs on a monitor (Fig. 3; modulator, 78 to TV, 30; column 6, lines 2-4);

an instruction receiving step (using remote control receiver, 48) for receiving user instructions (column 6, lines 11-15);

an instruction judging step (using microprocessor, 60) for judging whether the received user instruction corresponds to any of the stored user instructions (wherein the microprocessor determines whether a received command is a channel change command; column 4, lines 55-58 and column 6, lines 11-18);

a control step (through microprocessor, 60 executing the display method; column 6, lines 8-11) of controlling a reproduction period of the stored commercial content (time period in which the commercial can be displayed; column 5, lines 6-20) in accordance with a type of the received user instructions (in accordance with received channel change commands; column 5, lines 11-20); and

a second reproducing step for reproducing the stored commercial content on the monitor (column 6, line 67 and column 7, lines 1-8) under the reproduction period control of the control step (column 5, lines 6-20 and column 6, lines 8-11) when the

received user instruction is judged to one of the stored user instructions (column 6, line 67 and column 7, lines 1-8).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 9, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grossman as applied to claims 7 and 8 above, and further in view of Eyer et al. (Eyer) (6,588,015) (previously presented).

As to claims 9 and 12, while Grossman discloses a control means to prevent the reproduction of commercial content for subscribers (column 5, lines 11-20), he fails to specifically disclose:

termination instruction receiving means for receiving a termination instruction from a user to terminate the reproduction of the commercial content being reproduced; and

acceptance judging means for judging, in accordance with the type of the user instruction judged to correspond to one of the stored user instructions, whether the termination instruction should be accepted,

the control means has the second reproducing means

i) terminate the reproduction of the commercial content being reproduced when the termination instruction is judged to be acceptable, and

ii) continue the reproduction of the commercial content for a predetermined time period from the start of reproduction when the termination instruction is judged to be not acceptable.

In an analogous art, Eyer discloses a digital broadcast system (Fig. 1) which provides a plurality of service levels (column 2, lines 44-60) for digital audio, video or multimedia data (column 2, lines 36-39) comprising a means to receive the user instruction to skip (or terminate) a commercial (column 16, lines 41-45), a means to determine if the skip option should be allowed for the subscriber (Fig. 10, wherein only the pay customer asking to skip a commercial has access to jump to a point after the commercial; column 16, lines 51-59), wherein the skip option is available (an reproduction of the commercial terminated) only if the user is a found to be a subscriber (column 16, lines 37-60), and wherein a non-subscriber would have to reproduce the entire commercial (column 16, lines 56-59) for the typical advantage of allowing paying customers the convenience of skipping intrusive advertisements (column 2, lines 44-60).

It would have been obvious of to one of ordinary skill in the art at the time of invention by applicant to modify Grossman's system to include

termination instruction receiving means for receiving a termination instruction from a user to terminate the reproduction of the commercial content being reproduced; and

acceptance judging means for judging, in accordance with the type of the user instruction judged to correspond to one of the stored user instructions, whether the termination instruction should be accepted,

the control means has the second reproducing means

i) terminate the reproduction of the commercial content being reproduced when the termination instruction is judged to be acceptable, and

ii) continue the reproduction of the commercial content for a predetermined time period from the start of reproduction when the termination instruction is judged to be not acceptable, as taught by Eyer, for the typical benefit of allowing a service provider allow paying customers the convenience of skipping intrusive advertisements.

As to claims 10 and 13, Grossman and Eyer further disclose canceling means cancels (control CPU, 230 controlling the apparatus; see Eyer at Fig. 2; column 6, lines 34-39) the reproduction of the commercial content for a subscriber during a broadcast program when the broadcast program is a specified program (wherein the user specifies an advertisement in the current program to be skipped; see Eyer at column 16, lines 37-45).

7. Claims 11 and 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grossman and Eyer as applied to claims 10 and 13 above, and further in view of Blahut et al. (Blahut) (5,532,735) (previously presented).

As to claims 11 and 14, while Grossman and Eyer disclose a subscription judging means to determine whether a user is subscribed to a broadcast service (wherein only a pay customer can advance to a point after the commercial; See Eyer at column 16, lines 51-59) and wherein the canceling means cancels the reproduction of the commercial content when the broadcast service is judged to be a subscribed broadcast service (See Eyer at column 16, lines 37-60), they fail to specifically disclose a means to judge if a broadcast program is a pay program.

In an analogous art, Blahut discloses an interactive television system (Fig. 3; column 1, lines 7-9) comprising a means to determine if a viewer has selected a VOD (or pay) program (Fig. 5; step 228) whereupon the viewer can select if they wish to cancel a set of advertisements during that program (column 5, lines 27-35) for the advantage of allowing a subscriber a choice in advertising and billing amounts for a specific pay program (column 1, lines 34-36 and column 2, lines 19-24).

It would have been obvious of to one of ordinary skill in the art at the time of invention by applicant to modify Grossman and Eyer's system to include means to judge if the broadcast program is a pay program, as taught by Blahut, for the typical benefit of allowing a service provider to provide a subscriber with more choice in the advertising and billing amounts for a specific pay program.

Response to Arguments

8. Applicant's arguments filed 06/17/04 have been fully considered but they are not persuasive.

(a) Applicant's arguments on page 9 of the response fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

(b) On page 10, lines 12-15 of applicant's response, applicant implies that the ROM 40 of the Grossman reference was said to teach a registered instruction storing means, an instruction receiving means, and an instruction judging means.

In response, ROM, 40 was only referred to teach a registered instruction storing means. The instruction receiving means was actually met by remote control receiver, 48 and the instruction judging means was met by microprocessor, 60.

(c) On page 10, lines 15-16 of applicant's response, while applicant traverses the contention that the elements mentioned in (b) above are taught by the Grossman reference, evidence is provided as to how Grossman is deficient.

In response, applicant is directed to (4) above.

(d) On page 10, line 23 and page 11, lines 1-2 of applicant's response, applicant argues that Grossman fails to disclose or suggest a reproduction time control unit.

In response, applicant is directed to (4) above where it is shown that Grossman does in fact teach this element.

(e) On page 11, lines 8-13 of applicant's response, applicant argues that Grossman does not anticipate or render obvious claims 20 and 21.

In response, these claims are directed to an non-elected invention and have therefore been withdrawn from prosecution.

(f) On page 12, lines 8-9 of applicant's response, applicant argues that Eyer fails to disclose or suggest a reproduction time control unit.

In response, applicant is directed to (4) above where it is shown that the reproduction time control unit is in fact taught by the Grossman reference.

(g) In response to applicant's argument on page 12, lines 22-23, page 13, and page 14, line 1, that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The offering of a viewer more choice over billing and the advertisements is a benefit well known in the art in general and as stated in the Blahut reference as cited in (7) above.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____.
(Date)

Typed or printed name of person signing this certificate:

_____

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)_____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

_____

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (703) 305-8722. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda
Patent Examiner
Art Unit 2614

JS

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600